

the newly added claims.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

I. THE 35 U.S.C. §112 OBJECTIONS AND "FORMAL MATTERS":

The Examiner objected to claims 2, 3, 10, 18 and 19 under 35 U.S.C. §112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention". In particular, with respect to claims 2, 3, 18, and 19, the Examiner indicated that the meaning of the phrase "educational material review" and the phrase "said measure of review" is unclear. With respect to claim 10, the Examiner indicated that the meaning of the term "formal requirements" is unclear.

As noted above, Applicant has cancelled claims 3, 8, 10 and 20, without prejudice, and Applicant has added new claims 21-26. Applicant respectfully directs the Examiner to page 73, lines 5-10 of the Specification wherein the phrases

"educational material review" and "an amount of educational material review" are defined. The pertinent portion of the Specification reads as follows:

"The review or replay of the educational material can also be referred to as "educational material review" or any other equivalent term, phrase, or terminology. The amount of review or refresher material can also be referred to as "an amount of educational material review" or any other equivalent term, phrase, or terminology." Specification, page 73, lines 5-10.

In view of the above, Applicant respectfully submits that claim 2 ("educational material review"), claim 18 ("educational material review") and claim 19 ("an amount of educational material review") are in compliance with 35 U.S.C. §112, second paragraph. As noted above, Applicant has cancelled claims 3 and 10, without prejudice.

In view of the foregoing, Applicant respectfully submits that the pending claims are in compliance with 35 U.S.C. §112. Withdrawal of the objections to the claims is, therefore, respectfully requested.

## **II. THE 35 U.S.C. §103 REJECTIONS:**

The Examiner asserts that claims 1-9, 11, 12, and 15-19

are rejected under 35 U.S.C. §103(a) as being unpatentable over Houstis et al. (Internet, Education, and the Web) (Houstis) in view of Dunn, et al., U.S. Patent No. 5,721,829 (Dunn). The Examiner further asserts that claims 10, 13, 14 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Houstis in view of Dunn, and further in view of Goldberg (World Wide Web - Course Tool: An Environment for Building WWW - Based Courses) (Goldberg).

As noted above, Applicant has cancelled claims 3, 8, 10 and 20, without prejudice, and Applicant has added new claims 21-26.

Applicant respectfully submits that the Examiner's rejection of the pending claims is untenable. Applicant submits that the present invention, as defined by claims 1-2, 4-7, 9, 11-19 and 21-26, is patentable over the prior art.

IIA. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 1-2, 4-7, 9-15, 21, 22, AND 24, IS PATENTABLE OVER THE PRIOR ART.

Applicant submits that the present invention, as defined by claims 1-2, 4-7, 9-15, 21, 22, and 24, is patentable over the prior art. Applicant respectfully submits that the

present invention, as defined by independent claim 1, is patentable over Houstis in view of Dunn.

Applicant respectfully submits that Houstis, Dunn, or any combination of Houstis and Dunn, does not disclose or suggest an apparatus for providing educational materials which comprises a processing device, wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational material previously transmitted to the individual, all of which features are specifically recited features of independent claim 1.

Applicant respectfully submits that the Examiner's rejection of independent claim 1 is untenable. Applicant further submits that the Examiner has failed to establish a prima facie

case of obviousness, as required by 35 U.S.C. §103, in his rejection of independent claim 1. Applicant further submits that the Examiner's asserted obvious determination is contrary to controlling case law governing obviousness determinations, as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant submits that the Examiner has failed to show any teaching, suggestion, or motivation, for combining the teachings of Houstis and Dunn in order to arrive at his obviousness determination with regard to independent claim 1. Applicant respectfully submits that Houstis and Dunn, taken alone or in combination, fail to provide any teaching, suggestion, or motivation, for the combination espoused by the Examiner.

Applicant respectfully submits that the Examiner improperly relied upon certain teachings of Dunn in order to supply the missing elements of independent claim 1 which were not taught or disclosed by Houstis.

Applicant submits that the Examiner's reliance on and application of certain teachings of Dunn is untenable.

Dunn discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that channel and resuming so that a portion of the content is repeated. Applicant respectfully submits, however, that Dunn does not disclose or suggest an apparatus for providing educational materials. Applicant further submits that Dunn does not disclose or suggest an apparatus for providing educational materials which comprises a processor having the recited features of independent claim 1. Applicant further submits that Dunn pertains to an entirely different field than Houstis.

Applicant respectfully submits that the Examiner failed to follow controlling case law by failing to provide any evidence of any teaching, suggestion, or motivation, in Houstis or in Dunn to support the combination of said references. In In Re Dembiczak, the Court of Appeals for the Federal Circuit stated "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999. The Court of Appeals for the Federal Circuit also stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

Applicant respectfully submits that the Examiner's statements, in support for his combining of the teachings of Houstis and Dunn, lacked the clarity and particularity which is required by controlling case law. In re Dembiczak, 175 F.3d 994. Applicant further submits that the Examiner's statements in support for combining Houstis and Dunn were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

The Examiner, in the Office Action, dated November 16, 2000, stated:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Houstis with the ability to begin a subsequent transmission by retransmitting a portion of the material previously transmitted to the user as disclosed by Dunn. The rationale is as follows: it would have been desirable to enable a user to start and stop the transmission of material, whereby upon the subsequent transmission the user's memory was refreshed by replaying a portion of the material that had been previously transmitted. As Dunn teaches the desirability of retransmitting a portion of the material previously transmitted, one of ordinary skill in the art would have been motivated by Dunn's teaching to provide the remote education system of Houstis with the ability to start and stop a transmission, whereby the start of the subsequent transmission included a portion of the material previously transmitted, thereby refreshing the user's memory." Office Action, date November 16, 2000, page 3, line 19, to page 4, line 9.

Applicant submits that the Examiner's statements in support of his obviousness rejection are broad and conclusory and fail to provide the requisite showing of a teaching, suggestion, or motivation, in either Houstis or Dunn in order to support the Examiner's position. The Court of Appeals for the Federal Circuit has stated that "[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999.

Applicant respectfully submits that the Examiner's statements are broad and conclusory and provide no evidence in support of the asserted combination of Houstis and Dunn. Rather, Applicant submits that the Examiner's statements indicate that the Examiner improperly utilized hindsight to piece together the elements of the present invention, as defined by independent claim 1, from the teachings of Houstis and Dunn, only after using the Applicant's claimed invention as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350.

The Court of Appeals for the Federal Circuit in In Re Rouffet, stated:



"Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" In Re Rouffet, 149 F.3d at 1357 (Fed. Cir. 1998).

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of independent claim 1. Applicant further respectfully submits that the present invention, as defined by independent claim 1, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully requests that the rejection of independent claim 1 be withdrawn.

Applicant respectfully submits that the present invention, as defined by independent claim 1, is patentable over the prior art. Applicant also respectfully submits that claims 2, 4-7, 9-15, 21, 22, and 24, which claims depend directly or indirectly from independent claim 1, so as to include all of the limitations of independent claim 1 and which further serve to narrow the scope of independent claim 1, are also patentable as said claims depend from allowable subject matter.

Allowance of pending claims 1-2, 4-7, 9-15, 21, 22, and 24, is, therefore, respectfully requested.

IIB. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 16 AND 17, IS PATENTABLE OVER THE PRIOR ART.

Applicant submits that the present invention, as defined by claims 16 and 17, is patentable over the prior art. Applicant respectfully submits that the present invention, as defined by independent claim 16, is patentable over Houstis in view of Dunn.

Applicant respectfully submits that Houstis, Dunn, or any combination of Houstis and Dunn, does not disclose or suggest a method for providing educational materials in a network environment, comprising at least one of identifying, recording, and storing, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, wherein a subsequent transmission of said educational material to the individual commences from a second location which is located before said first location in said educational material, and further wherein said subsequent transmission of said educational material includes a transmission of at least a portion of said educational

material previously transmitted to the individual, all of which features are specifically recited features of independent claim 16.

Applicant respectfully submits that the Examiner's rejection of independent claim 16 is untenable. Applicant further submits that the Examiner has failed to establish a prima facie case of obviousness as required by 35 U.S.C. §103, in his rejection of independent claim 16. Applicant further submits that the Examiner's asserted obvious determination is contrary to controlling case law governing obviousness determinations, as set forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant hereby incorporates by reference herein, and reasserts, the arguments presented above in section IIA.

Applicant submits that the Examiner has failed to show any teaching, suggestion, or motivation, for combining the teachings of Houstis and Dunn in order to arrive at his obviousness determination with regard to independent claim 16. Applicant respectfully submits that Houstis and Dunn, taken alone

or in combination, fail to provide any teaching, suggestion, or motivation, for the combination espoused by the Examiner.

Applicant respectfully submits that the Examiner improperly relied upon certain teachings of Dunn in order to supply the missing elements of independent claim 16 which were not taught or disclosed by Houstis.

Applicant submits that the Examiner's reliance on and application of certain teachings of Dunn is untenable. Dunn discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that channel and resuming so that a portion of the content is repeated. Applicant respectfully submits, however, that Dunn does not disclose or suggest a method for providing educational materials. Applicant further submits that Dunn does not disclose or suggest a method for providing educational materials which comprises at least one of identifying, recording, and storing, a first location, having the recited features of independent claim 16. Applicant further submits that Dunn pertains to an entirely different field than Houstis.

Applicant respectfully submits that the Examiner failed to follow controlling case law by failing to provide any evidence

of any teaching, suggestion, or motivation, in either Houstis or in Dunn to support the combination of said references. In In Re Dembiczak, the Court of Appeals for the Federal Circuit stated "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999. The Court of Appeals for the Federal Circuit also stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

Applicant respectfully submits that the Examiner's statements in support of his combining of the teachings of Houstis and Dunn lacked the clarity and particularity which is required by controlling case law. In re Dembiczak, 175 F.3d 994. Applicant further submits that the Examiner's statements in support for combining Houstis and Dunn were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

As stated above, Applicant submits that the Examiner's statements in support of his obviousness rejection are broad and conclusory and fail to provide the requisite showing of a

teaching, suggestion, or motivation, in either Houstis or Dunn in order to support the Examiner's position. The Court of Appeals for the Federal Circuit has stated that "[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999.

Applicant respectfully submits that the Examiner's statements are broad and conclusory and provide no evidence in support of the asserted combination of Houstis and Dunn. Rather, Applicant submits that the Examiner's statements indicate that the Examiner improperly utilized hindsight to piece together the elements of the present invention, as defined by independent claim 16, from the teachings of Houstis and Dunn, only after using the Applicant's claimed invention as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of independent claim 16. Applicant further respectfully submits that the present invention, as defined by independent claim 16, is patentable over Houstis in view of Dunn. In this regard,

Applicant respectfully requests that the rejection of independent claim 16 be withdrawn.

Applicant respectfully submits that the present invention, as defined by independent claim 16, is patentable over the prior art. Applicant also respectfully submits that claim 17, which claim depends directly from independent claim 16, so as to include all of the limitations of independent claim 16 and which further serves to narrow the scope of independent claim 16, is also patentable as said claim depends from allowable subject matter.

Allowance of pending claims 16 and 17 is, therefore, respectfully requested.

**IIC. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 18, 19 AND 23, IS PATENTABLE OVER THE PRIOR ART.**

Applicant submits that the present invention, as defined by claims 18, 19 and 23, is patentable over the prior art. Applicant respectfully submits that the present invention, as defined by independent claim 18, is patentable over Houstis in view of Dunn.

Applicant respectfully submits that Houstis, Dunn, or any combination of Houstis and Dunn, does not disclose or suggest an apparatus for providing educational materials which comprises a processing device, wherein said processor processes said transmission termination signal and terminates the transmission of said educational material, and further wherein said processor at least one of identifies and stores a first location in said educational material where said transmission is terminated, wherein a subsequent transmission of said educational material commences from a second location, wherein said second location is a location in said educational material which is located before said first location and includes an amount of educational material review during said subsequent transmission, all of which features are specifically recited features of independent claim 18.

Applicant respectfully submits that the Examiner's rejection of independent claim 18 is untenable. Applicant further submits that the Examiner has failed to establish a prima facie case of obviousness, as required by 35 U.S.C. §103, in his rejection of independent claim 18. Applicant further submits that the Examiner's asserted obvious determination is contrary to controlling case law governing obviousness determinations, as set



forth by the Court of Appeals for the Federal Circuit. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

Applicant hereby incorporates by reference herein, and reasserts, the arguments presented above in section IIA.

Applicant submits that the Examiner has failed to show any teaching, suggestion, or motivation, for combining the teachings of Houstis and Dunn in order to arrive at his obviousness determination with regard to independent claim 18. Applicant respectfully submits that Houstis and Dunn, taken alone or in combination, fail to provide any teaching, suggestion, or motivation, for the combination espoused by the Examiner.

Applicant respectfully submits that the Examiner improperly relied upon certain teachings of Dunn in order to supply the missing elements of independent claim 18 which were not taught or disclosed by Houstis.

Applicant submits that the Examiner's reliance on and application of certain teachings of Dunn is untenable. Dunn discloses a system for automatic pause/resume of content delivered on a channel in response to switching to and from that

channel and resuming so that a portion of the content is repeated. Applicant respectfully submits, however, that Dunn does not disclose or suggest an apparatus for providing educational materials. Applicant further submits that Dunn does not disclose or suggest an apparatus for providing educational materials which comprises a processing device having the recited features of independent claim 18. Applicant further submits that Dunn pertains to an entirely different field than Houstis.

Applicant respectfully submits that the Examiner failed to follow controlling case law by failing to provide any evidence of any teaching, suggestion, or motivation, in Houstis or in Dunn to support the combination of said references. In In Re Dembiczak, the Court of Appeals for the Federal Circuit stated "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d at 999. The Court of Appeals for the Federal Circuit also stated that "... the showing must be clear and particular." In re Dembiczak, 175 F.3d at 999.

Applicant respectfully submits that the Examiner's statements in support of his combining of the teachings of

Houstis and Dunn lacked the clarity and particularity which is required by controlling case law. In re Dembiczak, 175 F.3d 994. Applicant further submits that the Examiner's statements in support for combining Houstis and Dunn were broad and conclusory and amounted to the Examiner's utilization of hindsight, which is improper. In Re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999).

As stated above, Applicant submits that the Examiner's statements in support of his obviousness rejection are broad and conclusory and fail to provide the requisite showing of a teaching, suggestion, or motivation, in either Houstis or Dunn in order to support the Examiner's position. The Court of Appeals for the Federal Circuit has stated that "[b]road conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'." In re Dembiczak, 175 F.3d at 999.

Applicant respectfully submits that the Examiner's statements are broad and conclusory and provide no evidence in support of the asserted combination of Houstis and Dunn. Rather, Applicant submits that the Examiner's statements indicate that the Examiner improperly utilized hindsight to piece together the elements of the present invention, as defined by independent

claim 18, from the teachings of Houstis and Dunn, only after using the Applicant's claimed invention as a blueprint, an approach which is untenable and contrary to the existing state of the law. In Re Rouffet, 149 F.3d 1350.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness in his asserted rejection of independent claim 18. Applicant further respectfully submits that the present invention, as defined by independent claim 18, is patentable over Houstis in view of Dunn. In this regard, Applicant respectfully requests that the rejection of independent claim 18 be withdrawn.

Applicant respectfully submits that the present invention, as defined by independent claim 18, is patentable over the prior art. Applicant also respectfully submits that claims 19 and 23, which claims depend directly from independent claim 18, so as to include all of the limitations of independent claim 18 and which further serve to narrow the scope of independent claim 18, are also patentable as said claims depend from allowable subject matter.

Allowance of pending claims 18, 19 and 23, is,  
therefore, respectfully requested.

IID. THE PRESENT INVENTION, AS DEFINED BY CLAIMS 25 AND 26,  
IS PATENTABLE OVER THE PRIOR ART.

Applicant respectfully submits that the present invention, as defined by claims 25 and 26, is patentable over the prior art. Applicant respectfully submits that the present invention, as defined by independent claim 25, is patentable over the prior art.

Applicant respectfully submits that Houstis, Dunn, Goldberg, or any combination of same, does not disclose or suggest an apparatus for providing educational materials which comprises a processing device, wherein said processing device terminates the transmission of said educational material in response to the termination signal, and further wherein said processing device at least one of identifies, records, and stores, a first location, wherein said first location is the location in said educational material where the transmission of said educational material is terminated, and further wherein a subsequent transmission of said educational material to the individual commences from a second location which is located

before said first location in said educational material, and further wherein said processing device stores information regarding at least one of said first location and said second location in an educational file corresponding to the individual, and further wherein said subsequent transmission of said educational material includes a transmission of an amount of educational material review, all of which features are specifically recited features of independent claim 25.

In view of the foregoing, Applicant respectfully submits that the present invention, as defined by independent claim 25, is patentable over the prior art. Applicant further submits that claim 26, which claim depends directly from independent claim 25, so as to include all of the limitations of independent claim 25 and which further serves to narrow the scope of independent claim 25, is also patentable as said claim depends from allowable subject matter.

Allowance of pending claims 25 and 26 is, therefore, respectfully requested.

### III. THE APPLICANT'S CHALLENGE TO THE EXAMINER'S TAKING OFFICIAL NOTICE.

Applicant hereby seasonably challenges each instance in

which the Examiner has taken Official Notice in the Office Action, dated November 16, 2000.

The Examiner, on page 4, lines 10-11, asserts "Official Notice is taken that video devices utilized for video conferencing are old and well known in the art." Applicant respectfully traverses the Examiner's taking of Official Notice in the above-identified instance and seasonably challenges same. Applicant respectfully demands that the Examiner produce evidence pursuant to M.P.E.P. §2144.03 to support the Examiner's taking of Official Notice in the above instance. Applicant further respectfully requests that the Examiner produce evidence in support of the subject matter of the Official Notice as it relates to an apparatus for providing educational materials.

The Examiner, on page 4, lines 16-18, asserts "Official Notice is taken that the ability to process financial transactions through a networked computer system (e.g., the Internet) is old and well known in the art." Applicant respectfully traverses the Examiner's taking of Official Notice in the above-identified instance and seasonably challenges same. Applicant respectfully demands that the Examiner produce evidence pursuant to M.P.E.P. §2144.03 to support the Examiner's taking of Official Notice in the above instance. Applicant further

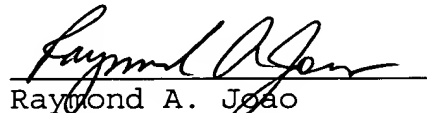
respectfully requests that the Examiner produce evidence in support of the subject matter of the Official Notice as it relates to an apparatus for providing educational materials.

IV. CONCLUSION:

In view of the above, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

A Fee Transmittal sheet (in duplicate) and a check in the amount of \$58.00, for the additional claims, is transmitted herewith.

Respectfully Submitted,



Raymond A. Joao  
Reg. No. 35,907

Encls: - Fee Transmittal Sheet (in duplicate)  
- Check in amount of \$58.00 for additional claims

February 14, 2001

122 Bellevue Place  
Yonkers, New York 10703  
(914) 969-2992